

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the currently pending claims are presented herein for convenience.

Claims 1-7 are left unchanged.

2. Rejection of claims 1-3, 5-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. US 2003/0132281 (*Jones et al.*) in view of U.S. Pat. No. 7,487,919 (*Giering et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claims 1-3, and 5-7.

As an initial note, it is respectfully submitted that the *Giering* patent is not available as prior art.

It is respectfully submitted that the pending application has a foreign priority date of December 23, 2003, from which the international patent application PCT/EP2004/014507 depends. Therefore, the pending application, which depends on PCT/EP2004/014507, has a filing date prior to the *Giering* patent's effective filing date of October 5, 2004. In lieu of this, a rejection under § 103 is precluded since the *Giering* patent is disqualified as prior art.

Turning to the *Jones* publication, it is respectfully submitted that the *Jones* publication does not teach the use of comparative data derived from authentic bank notes and known forgeries and the additional comparative data relating to new types of forgeries, as required by claims 1 and 6, as previously argued in the Appeal Brief dated December 9, 2009.

Specifically, the *Jones* publication only teaches the use of comparative data derived from authentic bank notes and known forgeries in order to detect counterfeit bank notes. At most, the *Jones* publication discloses updating a database with serial numbers associated with bills determined to be counterfeit (paragraphs [0093], [0142], [0143], [0148], [0182]-[0187]). Thus, these updated serial numbers are only associated with forgeries or counterfeit documents that are recognized based upon the *known* comparative data derived from authentic documents and known forgeries, and cannot be considered to be additional comparative data for *new* types of forgeries, as is required by pending claims 1 and 6.

The *Jones* publication simply fails to disclose the use of additional comparative data derived from new types of forgeries, which are not recognized based upon the comparative data derived from authentic banknotes and known forgeries, as is required by both claim 1 and claim 6.

The system according to the *Jones* publication is therefore akin to the types of systems discussed in the Background of the pending application wherein new forgeries are not recognized and are thus erroneously judged as an authentic bank note (specification at [0002]-[0004]). In other words, the system according to the *Jones* publication is simply incapable of recognizing new types of forgeries.

Accordingly, since the *Jones* publication fails to disclose all of the features required by pending claims 1 and 6 and the *Giering* patent is disqualified as prior art, the references fail to establish a *prima facie* case of obviousness with respect to claims 1 and 6, and reversal of this rejection is respectfully requested.

Claims 2-3, 5, and 7 are allowable for all the reasons given above concerning base claim 1 or 6, and further in view of their specific recitation. Accordingly, since the proposed combination of the references fails to disclose all of the features required by pending claims 1 and 6, the references fail to establish a *prima facie* case of obviousness

with respect to claims 2-3, 5, and 7, and reversal of this rejection is respectfully requested.

3. Rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. US 2003/0132281 (*Jones et al*) in view of U.S. Pat. No. 7,487,919 (*Giering et al*) and further in view of European Pat. No. EP 1,255,232 (*Pernot et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 4, in view of the discussion as to claim 1, from which claim 4 depends, on the basis that the *Pernot* patent fails to provide for the deficiencies of the *Jones* publication as discussed above in detail with respect to claim 1.

Accordingly, withdrawal of this rejection is respectfully requested.

4. Conclusion

As a result of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

Please charge any additional fees required or credit any overpayments in connection with this paper to Deposit Account No. 02-0200.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,  
  
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